

### **REMARKS**

Claims 1-22 are currently pending, wherein claims 1-5, 7, 8, 11, 13-17, 19 and 21 have been amended to correct typographical and/or translation errors. Applicants respectfully request favorable reconsideration in view of the remarks presented herein below.

At the outset, Applicants note with appreciation the indication that claims 4, 11, 12, 14, 16, and 19-22 contain allowable subject matter, and would be allowed if rewritten in independent form.

In paragraph 2 of the Office Action ("Action"), the Examiner rejects claims 1, 2, 5-8, 10, 13, 15, and 17 under 35 U.S.C. § 102(e) as allegedly being unpatentable over U.S. Patent No. 6,337,922 to Kumada ("Kumada"). Applicants respectfully traverse this rejection.

In order to support a rejection under 35 U.S.C. § 102, the cited reference must teach each and every claimed element. In the present case, claims 1, 2, 5-8, 10, 13, 15, and 17 are not anticipated by Kumada because Kumada fails to disclose each and every claimed element as discussed below.

Independent claim 1 defines a method of outputting image data generated relative to a first color space by an output device that converts image data of a second color space to a visually-perceptible analog thereof. The method includes, *inter alia*, receiving from a provider, over a communication channel, original image data that was generated according to a first color space, receiving from said provider, over a

communication channel along with the original image data, tag data representing parameters of the first color space, automatically converting, in said output device, the original image data into converted image data of the second color space, and converting the converted image data into a visually-perceptible analog thereof.

Kumada discloses an image processing apparatus and method for color matching in a network using a communication device which communicates with a network server storing a plurality of device profiles and color management modules. According to the method of Kumada, if image data exists in a file to be displayed, a color matching process on the image data is performed in accordance with the characteristics of the monitor in which the file is to be displayed. More specifically, once it is determined that color matching is to be performed, a user selects a profile corresponding to the scanner or device which created the image data from a profile storage unit of a network server. Then the selected profile is downloaded to the terminal, along with the destination profile (i.e. the profile corresponding to the device in which is the data is to be displayed). The image data is then color processed based on the source profile and the destination profile. However, nowhere in Kumada is there any disclosure of receiving the original image data along with the tag data from the same provider as claimed. Even if one skilled in the art were to equate the source profile with the claimed tag data, Kumada fails to disclose receiving the image data and the source profile together from the same provider. To the contrary, Kumada explicitly discloses storing the source profiles in a network server. Accordingly, Kumada fails to

anticipate independent claim 1 because Kumada fails to disclose each and every claimed element.

Independent claim 5 defines a method of outputting original image data generated relative to a first color space by an output device that converts image data of a second color space to a visually-perceptible analog thereof. The method includes, *inter alia*, receiving, from a provider over a communications channel, original image data generated according to a first color space, monitoring for the presence of tag data, the tag data representing parameters of a color space, over the communications channel, presuming if no tag data is received over the communications channel that said first color space is a default color space, and converting in the output device, the original image data into said second color space based upon the presumption that said first color space is the default color space to produce converted image data of said second space.

Nowhere in Kumada is there any disclosure of monitoring for the presence of tag data and presuming the first color space is a default color space if no tag data is received as claimed. Accordingly, independent claim 5 is patentable over Kumada because Kumada fails to disclose each and every claimed element.

Independent claims 13 and 15 defines image processing systems that include, *inter alia*, an output device configured to carry out the method of claims 1 and 5, respectively. Therefore, claims 13 and 15 are patentable over Kumada for at least those reasons presented above with respect to claims 1 and 5.

Claims 2, 6-8, 10, and 17 variously depend from independent claims 1, 5, and 13. Therefore, claims 2, 6-8, 10, and 17 are patentable over Kumada for at least those reasons presented above with respect to claims 1, 5, and 13. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1, 2, 5-8, 10, 13, 15, and 17 under 35 U.S.C. § 102(e).

In paragraph 4 (first occurrence) of the Action, the Examiner rejects claims 3 and 9 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kumada in view of U.S. Patent No. 5,359,437 to Hibe ("Hibe"). Applicants respectfully traverse this rejection.

In order to support a rejection under 35 U.S.C. §103, the Action must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness three criteria must be met. First, there must be some motivation to combine the cited references. Second, there must be a reasonable expectation of success. Finally, the combination must teach each and every claimed element. In the present case, claims 3 and 9 are not rendered unpatentable over the combination of Kumada and Hibe because the Examiner fails to establish a *prima facie* of obviousness as discussed below.

In rejecting claims 3 and 9, the Examiner asserts that it would have been obvious to one skilled in the art "to combine the teaching[s] of Hibi to the parameters of the color space in the profile taught in Kumada since Kumada teaches that the profile is for color conversion between input and output images corresponding to a source device before

conversion and a profile." In other words, the Examiner asserts that one skilled in the art would have been motivated to modify the device profiles of Kumada to include the under-color removal method of Hibi because Kumada discloses that the profiles are used for color conversion. However, nowhere in Kumada or Hibi is there any disclosure or suggestion of the desirability of under-color removal in the image processing system of Kumada. Nor has the Examiner provided any evidence that the device profiles of Kumada can be modified to include the under-color removal method of Hibi. The mere fact that reference *may* be combined does not rendered the resultant combination obvious. (See MPEP §2143.01). Accordingly, absent proper motivated to combine Kumada and Hibi, the rejection of claims 3 and 9 is improper.

Furthermore, even if, *arguendo*, one skilled in the art were motivated to combine Kumada and Hibi, the combination would still fail to render claims 3 and 9 unpatentable because the combination fails to disclose each and every claimed element. Nowhere in Kumada or Hibi is there any disclosure or suggestion of receiving the original image data along with tag data as claimed.

Since both Kumada and Hibi fail to disclose or suggest a method for outputting original image data that includes receiving from a provider original image data generated according to a first color space and tag data representing parameters of the first color space as claimed, the combination of these two references cannot possibly disclose or suggest said element. Therefore, even if one skilled in the art were motivated to combine Kumada and Hibi, which Applicants do not concede, the

combination would still fail to render claims 3 and 9 unpatentable because the combination fails to disclose each and every claimed element. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 3 and 9 under 35 U.S.C. § 103(a).

In paragraph 5 of the Action, the Examiner rejects claim 18 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kumada in view of U.S. Patent No. 6,509,910 to Agarwal et al. ("Agarwal"). Applicants respectfully traverse this rejection.

Claim 18 depends from independent claim 13. Therefore, claim 18 is patentable over Kumada for at least those reasons presented above with respect to claim 13. Agarwal discloses a method of sending data between multiple networks. However, Agarwal fails to overcome the deficiencies of Kumada.

Since both Kumada and Agarwal fail to disclose or suggest a system for outputting original image data that includes receiving from a provider original image data generated according to a first color space and tag data representing parameters of the first color space as claimed, the combination of these two references cannot possibly disclose or suggest said element. Therefore, even if one skilled in the art were motivated to combine Kumada and Agarwal, which Applicants do not concede, the combination would still fail to render claim 18 unpatentable because the combination fails to disclose each and every claimed element. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 18 under 35 U.S.C. § 103(a).

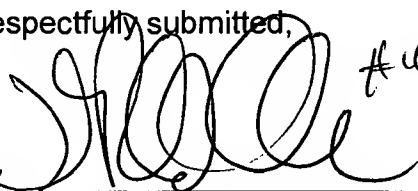
In paragraph 4 (second occurrence) of the Action, the Examiner objects to claim 21 for containing a typographical error. Claim 21 has been amended to correct the typographical error, thereby addressing the Examiner's concerns.

The application is in condition for allowance. Notice of same is earnestly solicited. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Penny Caudle (Reg. No. 46,607) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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